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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,656	11/09/1999	KENJI TAGAWA	00177/530318	6961

7590 01/28/2003
WENDEROTH LIND & PONACK
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WASHINGTON, DC 20006

EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/28/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,656

Applicant(s)

Tagawa et al.

Examiner

O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 22, 2002 (Amdt "A") and November 12, 2002 (Election).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above, claim(s) 29-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Preliminary Remarks

1. This Office action has been prepared in response to the amendment and arguments filed by applicant on July 22, 2002 (Paper N^o 9), and the response to restriction requirement filed by applicant on November 12, 2002 (Paper N^o 11).

2. Applicant's revisions to the specification and abstract, cancellation of claims 1-21, and addition of claims 22-42, are all hereby acknowledged.

Election/Restriction

3. Applicant's election without traverse of the invention of Group I, claims 22-28, in Paper N^o 11 is hereby acknowledged.

4. Claims 29-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper N^o 11.

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Claim Rejections - 35 USC § 112, Second Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation “the received audio contents” in line 23. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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8. Claims 22-28, as best understood, in light of their rejection under 35 U.S.C. 112, hereinabove, are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et al. Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight. See MPEP §2114.

Imai et al. show a data conversion apparatus 100 comprising: a data transmission/receiving section 11; a data format judging section 3; an attribute information obtaining section 4; a data format conversion section 5; and a controller 1.

Regarding claim 23, the data conversion apparatus of Imai et al. further comprises a data outputting section 6.

Regarding claim 24, the data conversion apparatus of Imai et al. further comprises a recording section 105 and a charging section 104.

Regarding claim 25, the data transmission/receiving section of Imai et al. includes a data read-out portion 6 and a network interface 102.

Regarding claim 26-28, the recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight. See MPEP §2114.

9. Claims 22-28, as best understood, in light of their rejection under 35 U.S.C. 112, hereinabove, are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight. See MPEP §2114.

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Yoshida et al. show a data conversion apparatus 11 comprising: a data transmission/receiving section 2; a data format judging section; an attribute information obtaining section 1; a data format conversion section 3; and a controller 51.

Regarding claim 23, the data conversion apparatus of Yoshida et al. further comprises a data outputting section.

Regarding claim 24, the data conversion apparatus of Yoshida et al. further comprises a recording section 4 and a charging section 16.

Regarding claim 25, the data transmission/receiving section of Yoshida et al. includes a data read-out portion and a network interface.

Regarding claim 26-28, the recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight. See MPEP §2114.

Response to Arguments

10. Applicant's arguments filed July 22, 2002 have been fully considered but they are not persuasive.

11. Regarding the argument that the references listed on the previously submitted IDS should all be considered, notwithstanding the lack of copies thereof, for the reason that copies were not required as of the date of submission of the IDS, the argument fails to address the main issue at hand. The issue of whether or not the copies of the documents are, or were, required by rule is

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not the determinative issue. The examiner is obviously not going to sign a document indicating that references have been considered if the examiner has not even seen the documents. As the cited documents are all active applications assigned to other examiners and therefore unavailable to the examiner, the cited references cannot be considered by the examiner, thus will not be indicated as having been considered by the examiner.

If applicant still wants to have the references considered, applicant should submit a new IDS citing the references to be considered on a new form PTO-1449, together with copies of the cited references and the appropriate fee. The examiner will then expeditiously consider the references and happily indicate such consideration on an initialed copy of the form PTO-1449 to be returned to applicant.

12. Regarding the argument that neither Imai et al. nor Yoshida et al. disclose using their respective data conversion apparatuses with the specific copyright/data protection scheme known as “superdistribution” (though both discuss superdistribution) a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Conclusion

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC

January 22, 2003



Richard Chilcot
Supervisory Patent Examiner
Technology Center 2003

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